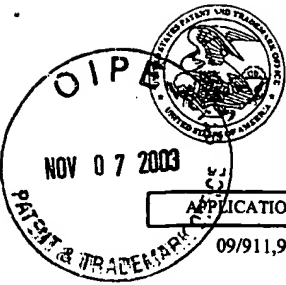


1772



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,949	07/24/2001	Thomas Louis Russo		5696

7590  
Thomas Louis Russo  
7 Avenue D  
Rutland, VT 05701

07/01/2003

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NOV 13 2003

TC 1700

EXAMINER
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NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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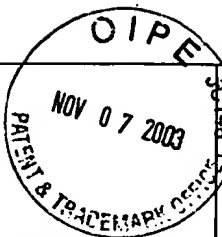
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DATE MAILED: 07/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**



Application No.

09/911,949

Applicant(s)

RUSSO, THOMAS LOUIS

Examiner

Patricia L. Nordmeyer

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-4.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

**Continuation of #2:** Applicant has amended independent claims 1 and 4 by adding proposed new limitations “valve less” which require a new search and or further consideration.

### **ENTRY NOT A MATTER OF RIGHT**

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

- (A) an amendment complying with 37 CFR 1.116;
- (B) a Notice of Appeal (and appeal fee); or
- (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

**Continuation of #5:** The application is not placed in condition for allowance because:

Applicant's arguments are drawn to a proposed claim amendment which is not being entered.

Thus, the arguments are not commensurate in scope with the claims. Specifically, the applicant's arguments are drawn to the limitation of “valve less” which has not been entered.

Therefore, the arguments are moot as they are not commensurate in scope with the claims of record. Applicant's arguments of record are not found persuasive because they rely on the non-

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entered amendments. Applicant is referred back to the final rejection of record in Paper #5, mailed on March 19, 2003.

Applicant is asked to read the following section (b) from the *Manual of Patent Examination Procedures* regarding the 37 CFR 1.116 regulations when amending claims after final rejection. Applicant's amendment to the claims has not been entered and prosecution has been closed on the case after the final rejection filed on March 19, 2003. The amendment to the claims changes the claimed structure of the invention, which would require a new search for prior art which reads upon the structure claimed in the new claims.

**§ 1.116 Amendments after final action or appeal.**

- (a) An amendment after final action or appeal must comply with § 1.114 or this section.
- (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section.
- (c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

Art Unit: 1772

(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 1.196 or § 1.977.

Regarding section (a) of 37 CFR 1.116, the amendments must comply with 37 CFR 1.114. As explained in section (b), the amendments in must place the rejected claims in better for consideration in order to be entered. The amendments presented in the reply fail to meet this criteria. Nor, do the amendments or the arguments show sufficient reasons as to why the amendments were necessary and not presented earlier in the prosecution, section (c). Section (d) is not applicable at this present time.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure as the arguments presented by the Applicant are continually directed towards limitations which are contained in the specification and not the claims or limitations that are not clearly stated in the specification. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C.

20402.

Art Unit: 1772

The specification of the applicant should clearly state and include all of the limitations and embodiments of the claimed invention in order for the patentability of the invention to be determined by the Examiner. It maybe in the best interest of the Applicant to file a continuation or continuation-in-part of the invention where the structure of the article is clearly disclosed and claimed, both in the article's initial use and in its reusable state.

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

pln  
June 26, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

6/26/03



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Tom Russo  
7 Avenue D  
Rutland, VT 05701  
October, 31 2003

Mr. Nicholas Godici  
Commissioner of Patents  
U.S. Department of Commerce  
Patent and Trademark Office  
Washington, DC 20231

Dear Mr. Godici,

I wonder if I can have a moment of your time. I have an application that was being reviewed by an examiner in Art unit 1772.

Please accept this letter as an opportunity for you and your staff to observe the interaction between the patent office and a home based inventor. I have been confronted by process, the examiner's level of understanding and penalty fees throughout this application review. I understand that process applied correctly and proper fees collected make the patent office a more efficient organization. I also understand that every examiner will bring different levels of experience to a review. The problem arises when an inventor's ability to move forward with a patent application is stopped because the reviewing examiner fails to understand the basic concept of the invention, and proceeds to compare the application to inappropriate patent references. Now the examiner only has process to rely on, and in an effort to present an acceptable performance level within the patent office, the examiner must continue to support his/her previous inaccurate statements cited to compare the application to inappropriate referenced patents. The process appears to restrict the examiner from suggesting the examiner's human limitations. Process does not allow the examiner to take responsibility for a mistake or lack of understanding. Rather process, requires additional process that burdens the examiner, misrepresents the patent office, and stops the inventor's ability to go forward towards receiving a patent. The inventor's attempt to provide the requested additional information and clarification is confronted with indefensible statements presented by the examiner and inappropriate penalty fees levied by the patent office.

I know that you are busy in directing and overseeing the entire patent and trademark institution and I appreciate you reading the first portion of this letter. But I was hopeful that you would be able to use the information in the enclosed responses, to help improve the patent office interaction with home based inventors. More home based inventors might submit applications to successful completion if you had more insight into an applicant's involvement with your organization. I understand you probably don't want to hear that more home based inventor are going to submit applications, we take more examiner's time because of our inexperience with the bewildering and staggering level of process. We are willing to be instructed on process because we believe in our ideas, and we have hope that they will be of value to our families and the nations families.

If I can be of any help in giving a greater insight into your organization's process from an applicant's point of view, please don't hesitate to call 802-775-5242.

As you will see from the enclosed responses my application process has stopped because of the reviewing examiner's initial direction, and the request for a penalty fee that was requested by a phone call from a patent office clerk on October 16 2003 for \$470 required before the examiner would review the last response to the last office

action. If it were truly an extension then the fee would be correct. The examiner stated that the June 17 2003 response did not meet her requirements in a July first mailing. This latest office action dated July 1 2003 indicated the period for reply expires three months from the final rejection. July first was the latest rejection, and I submitted the response to this action on September 16 2003. The clerk indicated that the response to the July 1 2003 action was actually still due by June 19 2003.

A question for your staff is how would I have met the June 19 deadline if I did not know until July first that my June response was rejected, and why did the July office action indicate the period for reply expires three months from the final rejection?

The fee is a simple process issue, when you review the cited patents referenced by the examiner you will understand the greater challenge is the examiner's basic lack of understanding of the need for this invention. This lack of understanding is the basis for the penalty fee, and the examiner would not review the latest response that may improve the examiners understanding that would have eliminated the need for a fee initially... and so the loop for better understanding and penalty fee continues to widen. Paying legitimate fees is certainly understandable, but paying a penalty fee because of the examiners lack of understanding seems to be asking a great deal of an applicant.

Thank you for your time and attention,  
Sincerely,

A handwritten signature in black ink, appearing to read "Tom Quinn". The signature is fluid and cursive, with a large loop at the beginning and a long, sweeping underline.

Cc. Director of the Patent Office James Regan , Senator Patrick Leahy, Senator James M. Jeffords,  
Representative Bernie Sanders, Senate Judiciary Committee.

Application Control Number 09/911,949



Application Control Number: 09/911,949  
Applicant: Russo, Thomas Louis  
Art Unit: 1772  
Examiner: Patricia L. Nordmeyer

Ms. Nordmeyer,

I have received your Office Action Summary postmarked November 5, 2002. Thank you for your efforts in reviewing my application. I have attempted to answer each element in your office action as they were listed and I have used pictures of exhibits to help guide you through my answer. I have also included a marked up copy of the original claim pages, as well as clean revised pages of the corrected claims.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/911,949	RUSSO, THOMAS LOUIS	
	Examiner	Art Unit	
	Patricia L. Nordmeyer	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on \_\_\_\_\_

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "adapted to" in claims 1, 2 and 4 is unclear, which render the claims vague and indefinite. The phrase "adapted to" is not a positive limitation on the claim. The article only has to be capable of being re-inflated.

The phrase "said pad further comprising said entry/exit portal tube passageway" in claims 1 and 4 is unclear, which render the claims vague and indefinite. It is unclear from the claim language if there are two separate and distinct entry/exit portals, or if there is only one portal wherein the portal is configured to permit re-inflating.

Correction/clarification is required.

Ms. Nordmeyer, I hope I answered this request for clarification correctly. I removed the phrase "adapted to" from claims 1, 2, and 4. I also removed the phrase "said pad further comprising said entry/exit portal tube passageway" that repeated itself in claim 1 and 4.

In an effort to clarify my specific invention, I took the text "each said zone may be further broken down into a plurality of inflatable chambers, wherein said chambers are conical shaped providing a high volume profile" with added zoned impact security From my Summary of Invention page 4 line 21 that identified the conical shape or similar triangular shape required to obtain the high volume from our pad design.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaszai (USPN 5,826,723).

Jaszai discloses two flexible wall members, film (Column 12, lines 7 - 10), placed next to each other and sealed together through heat-sealing along the perimeters and through the internal area making two separate inflatable areas (Column 4, lines 1 - 7 and Figure 20, #14) which form an impact resistant wrapping, packing, system (Column 3, line 63). The wrapping system contains an intake tap for each of the separated inflatable areas (Column 7, lines 36 - 38 and Figure 20, #3). Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article (Figure 20, #3 and 5), allowing the wrapping system to be reused (Column 2, lines 22 - 25). The areas have also been adapted to redistribute the air through the formed chambers when pressure has been applied to the chambers (Column 7, lines 41 - 47).

Ms. Nordmeyer, I reviewed Mr. Jaszai patent you provided, two flexible wall members, film ( Column 12, lines 7-10) Line 7 of column 12 is the beginning of Mr. Jaszai Claim 11 which began " The impact wrapping system of claim 9, " The words or similar words " two flexible wall members, film" appears to be a common way to describe the containment of most inflatable related inventions. Mr. Magid patent inflatable Articles and Method of Making Same, uses the following Claim 2 column 7 line 14 " said inflatable unit is comprised of two sheets of thermoplastic materials located with one on top of the other having coinciding inner and outer portions, with seals at and within said outer portions," Mr. Soroka in his patent Inflatable Packing Structure uses similar language in his claim 2 column 4 line 4 " wherein the first and second inflatable layers each comprise two superposed portions of flexible sheet plastic materials."

I wasn't sure how to fix the line in my claims 1 and 4 "said first and second film layers being secured together along an outer perimeter thereof to define an inner volume within said pad and", I was trying to identify my invention as being part of this formation of these two layers of film. I hope that the next line with the clarification of the conical chambers developed by these two films will help make

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this claim and claim 4 acceptable. These are the corrected lines for claims 1 and 4: said first and said second film layers within said inner volume in a location selected to form at least two separate zones within said inner pad volume, and each said zone may be further broken down into a plurality of inflatable chambers, wherein said chambers are conical shaped providing a high volume profile with added zoned impact security

The line , placed next to each other and sealed together through heat-sealing along the perimeters and through the internal area making two separate inflatable areas (Column 4, lines 1-7 and figure 20,#14) This line was not a claim of Mr. Jaszai but was from a line in his Detailed Description of The Preferred Embodiments. Column 4 lines 1-7 " As shown in Fig 1, a sheet like wrapping body 1 in this embodiment is formed by putting two rectangular flexible wall members 11 and 12 one on top of the other and sealing, with an adhesive or by thermal welding, the four peripheral sides and portions which are parallel to two of the aforesaid four sides and spaced at regular intervals to hereby form seal portions 13. Column 4 lines 7-9 does direct a difference to shape " Thus, there are definitely partitioned rectangular wall chambers 14 among the seal portions 13 between the flexible wall members 11 and 12.

In this portion of the office action I felt you were directing my attention to fact that the edges of the film heat-sealed along the perimeters and through internal areas making two separate inflatable areas.. Here I hope I took your direction properly by clarifying my claims with the conical shape , I reviewed Mr. Jaszai fig 20,# 13 and 14 and he identifies a unique pattern to his internal shapes. Column 7 line 32-36 " the seal portion 13 for dividing the inner space of the sheet like wrapping body 1 into two wall chambers 14 is arranged in a continuous zigzag. Each wall chamber 14 elongated in zigzag is subdivided into generally U-shaped compartments by intermediary taps 9." Suggesting as you identified that shape was important to his invention as it is to mine, that without the cone or triangular shape my invention could not provide a higher volume profile to improve impact protection. It did occur to me based on the inventions you provided for my review, that there as several very basic difference from my invention's intended use and its design. Mr. Jaszai identifies his invention as a wrapping system, Mr. Soroka also speaks about his invention as an envelop wrapping around an article to be shipped, and Mr. Magid does not refer to or claim that his invention can be used in any manner to act as a item wrap for shipping like Mr. Jaszai and Mr. Soroka, or in the case of my invention non of the reviewed inventions suggest or refer to my inventions intended use to be an alternative to void fill. Our pads are meant be placed between an object and the container, each pad is not designed to wrap around a product but to take the place of void fill, such as paper and shipping beans , and hold secure an article that maybe wrapped with bubble wrap or Mr. Jaszai and Mr. Soroka's inventions, not to replace them. There are some inflatable pillows that are being used for light duty void fill today, but a single rupture will deflate them and they are not reusable from a deflated state. Our invention was designed to fill this needed area in inflatable void fill that has an added value of at least two zone protection and they are reusable from a deflated state.

Another significant difference between Mr. Jaszai, Mr Soroka and Mr. Magid inventions and mine is that each of them have a valve, some have one way valves, some have snap

lock valves. My invention has no valves, my pads are meant be inflated as they are formed from sheet film and placed in shipping boxes as they are needed. When they arrive at the end user they could be reused in this inflated state or they can be simply deflated by snipping the end of the portal tube, there are no valves just a tube if the pad is to be reused after deflation, but the tube is not required for initial inflation.

I noticed the difference you were pointing out in the office summary "The wrapping system contains an intake tap for each of the separate inflatable areas ( Column 7, lines 36-38 and fig 20,#3) Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article ( Fig 20, #3 and #5), allowing the wrapping system to be reused ( Column 2, line 22-25). Since my invention need no vales to be inflated and is intended to be inflated as the pad is formed from sheet material are portals are merely extensions of the upper and lower film. Mr. Jaszai invention requires a separate intake and exhaust tap, because air moves in one direction in his wrapping system, he has several interior one way vales that are intended to protect zones from leaking if a near by chamber is punctured. But this design with one way valves in interior chamber reduced the pads ability to transfer air under pressure to a connecting chamber, because once air move across the one way valve it will not move back and could actually be the cause of his wrapping system failing when a package is taking repeated impact through shipping. The basic difference is my invention has no one-way interior vales, air is allowed to move back and forth through connected conical chambers. My invention does not require a separate intake and exhaust tap. I have a tube that can be cut if you want to store our pad deflated and the same tube will be the inflate tube when you want to reuse our pad. As I review each of the other inventions they are meant to wrap an article, so you would probably use just one per package, our invention is designed for void fill and you would use several of our pads to every shipping box.

In the statement "The areas have also been adopted to redistribute the air through the formed chambers when pressure has been applied to the chambers ( Column 7, lines 41-47)" In this statement I though you were drawing my attention to the difference in the way my invention distributes air that is being compressed by an impact in shipping from one conical chamber to a connected conical chamber, and Mr. Jaszai 's wrapping pad does not as noted in Column 7 line 41-47 " According to this embodiment, the gas 10 filled in the wrapping body can be discharged by pressing the inflated wall chambers 14 without using the exhaust pipe 6 as described above. The intermediary taps 9 in this embodiment have the function of the exhaust tap5." So Mr. Jaszai 's wrapping pad does not redistribute air but can discharge air when you compress a chamber indicating air will not move back into a discharged chamber. As I noted above, our invention does redistribute air when a shipping impact presses on a single conical shaped air chamber and that air will move back when the impact pressure is reduced.

I hope I covered all the areas you define in the appropriate way and that my answers were correct and have clarified my claims so that you may accept them. Please if I have not done this correctly. Please call me at 802-775-5242 so that I can correct my writing to be acceptable.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Application/Control Number: 09/911,949  
Art Unit: 1772

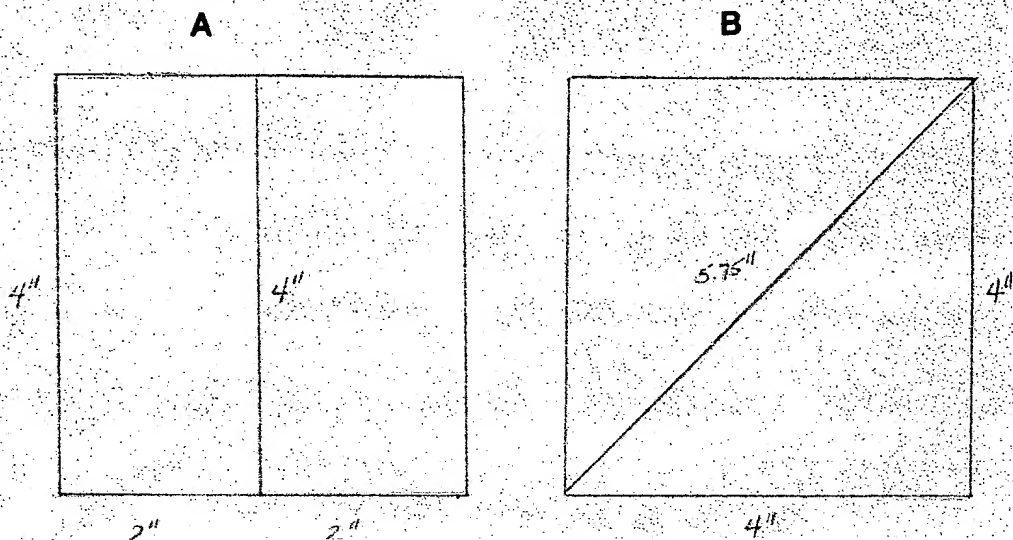
Page 4

Jaszai discloses the claimed wrapping system above including the chambers maximizing available pad surface (Figure 20, #14); however, Jaszai fails to disclose the chambers being substantially conical in shape.

I hope I have made Claim 3 acceptable ,

3. The system of claim 2 , wherein said conical shaped chambers maximize pad height for impact protection, said pad height respective of available chamber height determined by base width of conical chambers provided.

I reviewed your suggested section (Column 7 lines 33-35, FIG 20,#14)" into two wall chambers 14 is arranged in a continuous zigzag. Each wall chamber 14 elongated in zigzag is subdivided into generally U-shaped compartments by intermediary taps 9." a did note that Mr. Jaszai did describe a specific shape of each compartment as U shaped and that the subdivision was created by a zigzag design format. That allow me to understand that our compartments were cone or triangle shape and that we had a specific triangle or cone pattern to develop our subdivision of our pads. And that a cone shape would not work with Mr. Jaszai's format because our cone or triangle designs have a base end on one pad perimeter and the top end of the cone or triangle at the opposite perimeter . Cone shape chambers allow our pad to present a higher profile, because pad height is determine by the smallest chamber dimension.



The sketch above will hopefully help illustrate the statement that a chamber height is determined by its smallest dimension. A and B represent a four inch square, consider then inflatable pads. When we divide pad A in half using a rectangle chamber like Mr. Jaszai's wrapping pad the smallest dimension is 2 inches, but when you use a cone shape or triangle shape similar to pad B like our pad the smallest dimension is 4 inches. The cone shape does make a significant difference in obtaining a higher pad profile providing a void fill pad with greater impact protection and requiring less void fill pads to pack like shipping boxes using lower profile pads.

Ms. Nordmeyer, will that example be sufficient to allow me to use shape as an important part of my invention?

Art Unit: 1772

One skilled in the art would have been motivated to do so in order to use the entire inflatable space formed when the two pieces are sealed together.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Magid (USPN 4,629,433).

Magid discloses a central wall member made from film (Column 4, lines 52 – 54), where individual sheets of plastic are placed next to each other and sealed to the central layer (Column 4, lines 54 – 56), forming a first layer through heat-sealing along the perimeters (Column 4, lines 30 – 33) making separate inflatable areas (Figure 4, #22 and Column 4, lines 54 – 56) which form an impact resistant wrapping, packing, system. The inflatable article contains an intake tap for each of the separated inflatable areas (Column 4, line 56 and Figure 4, #23). Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article (Figure 4, #23), allowing the wrapping system to be reused (Column 6, lines 60 – 65). However, Magid fails to disclose a second layer on the opposite side of the central layer to form at least four separate areas within the inner pad volume.

Magid discloses the claimed invention except for a second layer on the opposite of the first layer which formed separate areas on the pad surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place individual sheets of plastic material on the opposite side of the central layer which are sealed to the central layer to form inflatable areas having their own valve control on the surface of the article, since it has

I must admit that Claim 4 being unpatentable over Magid I am a little confused with. I would like to go through it step by step if that is OK with you.

From the office summary “Magid discloses a central wall member made from film (Column 4, lines 52-54) where individual sheets of plastic are placed next to each other



and sealed to the central layer ( Column 4, lines 54-56), ” When I reviewed Column 4 , lines 52-56 “ A fourth type of basic inflatable is shown in Fig.4 which comprises a single sheet of thermoplastic material 20 to which is attached individual sheets of thermoplastic materials forming individual inflatable units 22 each having its own inflating valves 23 thereon.” I did not see any reference to a central wall member made from film. I took your direction to point out the significant difference between Magid and my invention.

Magid has a single sheet of thermoplastic material 20 to which is attached individual sheets of thermoplastic materials forming individual inflatable units 22. These are not zoned pads that share air moving from one chamber to another, 22 represents individual columns of air with separate valves, once punctured each chamber deflates and pad integrity is reduced. Magrid states column 4 line 57 -60 “ The purpose of these types of basic inflatables is to provide the opportunity to use materials of different colors, thicknesses, firmness etc. as may be required by the inflatable article.” It appears Magrid was considering an inflatable item, not an impact resistant wrapping, packing system. I could find no reference by Magrid or claim of an impact resistant wrapping packing system, in fact he references articles like swimming aids Fig 14 column 4 line 14, and inflatable lamp shades Fig 15 column 4 line 16. I attached a copy of Column 4 of Magrid on the next page, so that you might understand my review questions. And if in fact Magrid was an impact resistant wrapping it would fall into the same category as Jaszi and Soroka developed to wrap around an article not to act as void fill where I believe my invention can offer improvement.

Office summary statement “ The inflatable article contains an intake tap for each of the separated inflatable areas ( Columns 4, line 56 and figure 4,#23) This is a significant difference to my invention in that there are no individual intake taps that each zone controls a complete side of a pad and the air moves freely through all connected cone shaped air chambers in a zone. That my invention is designed to be filled with air when constructed and can be reused in the same state, and only if you want to deflate our pad to store reuse is simply blowing through a portal tube that fills all zones and all chambers in one action and by simply folding the portal tube and tucking it under a small retaining film, air remains in the pad providing impact protection with multiple zones each with connected chambers that redistribute impact compressed air.

Office summary statement “Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article ( Figure 4,#23). Here again I thought you were pointing out the deference between my invention with no need for intake taps, my invention was designed to be made from the film layer, there are no additional valves or taps one run through a film press with my design will create a complete operating high volume void fill unit. This would keep the cost down add allow it to be an alternative to void fill that can not be reused.

Office summary statement “ allowing the wrapping system to be reused ( Column 6, lines 60-65” “ Although the present invention has been described hereinbefore by way of preferred embodiments, it should be understood that various changes or modifications are still possible by those skilled in the art without departing from the spirit and scope of the present invention.” I understand the spirit and scope to be inflatable articles such as swimming aids and lamp shades and the like. And that its chambers don’t act as zones but separate chambers making their use as void fill expensive and unable to compete with current void fill methods.

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FIG. 7

FIG. 9 is a perspective view of another embodiment of the basic inflatable having opening and ruffles at the selected inner portion to be stabilized;

FIG. 10 is a perspective view of the parallel joining of the inflatable article of the present invention;

FIGS. 11a, 11b and 11c are perspective views of a series of in-line joinings of the inflatable article of the present invention;

FIG. 12 is a sectional view of the tubular joining of the present invention;

FIG. 13 shows a perspective view of the inflatable article of the present invention having holes provided thereon for joining to another article or component;

FIG. 14 is a perspective view of a swimming aid formed by using the method and article of the present invention;

FIG. 15 is a perspective view of a lamp with a lamp shade embodiment made by using the method and article of the present invention;

FIG. 16 shows an inflated state of an inflatable article which has been stabilized along the direction parallel to the centerline according to the present invention; and

FIG. 17 shows a deflated state of an inflated article as shown in FIG. 16.

#### DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

Referring to FIGS. 1 to 4 which show four types of basic inflatables according to the present invention, a basic inflatable 10 of the first type shown in FIG. 1 is made of two sheets of air impervious thermoplastic sheet materials heat sealed together with a plurality of vertical bar seals 11 within the outer portions and an inflating valve 12 provided on one of said two sheet materials for injecting air into the basic inflatable 10. Since the bar seals 11 do not touch the seals at the outer portions 14, air contained therein can pass between the inflatable spaces 13 formed by the bar seals 11.

A second type of the basic inflatable is shown in FIG. 2 wherein the bar seals 14 extend to and touch the seals at the outer portions forming a number of individual inflatable units 15 each having a valve 16.

FIG. 3 shows a third type of the basic inflatable which comprises a plurality of individual inflatable units 17 each having an inflating valve 18 provided thereon. Said units 17 are joined by their overlapped outer portion 19 to form a basic inflatable. The outer portions 19 of two adjacent inflatable units may be joined with an edge parallel joining as shown in FIG. 3a or a butt parallel joining as shown in FIG. 3b.

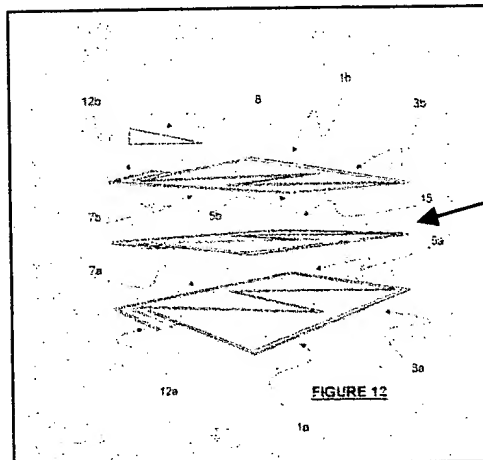
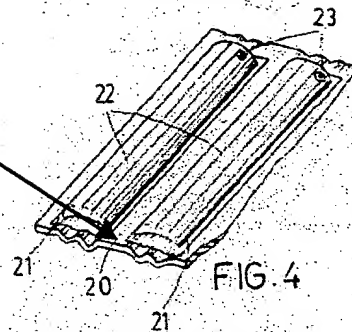
A fourth type of the basic inflatable is shown in FIG. 4 which comprises a single sheet of thermoplastic material 20 to which is attached individual sheets of thermoplastic materials forming individual inflatable units 22 each having its own inflating valve 23 thereon.

The purpose of these types of basic inflatables is to provide the opportunity to use materials of different colors, thicknesses, firmness etc. as may be required by the inflatable article.

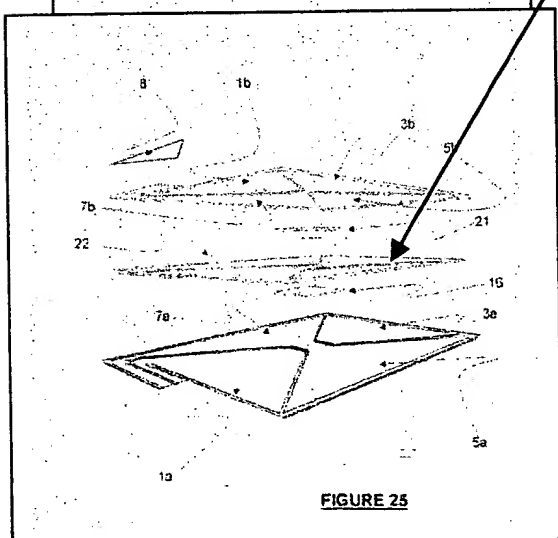
Referring to FIG. 5 which shows a perspective view of a basic inflatable, two sheets of thermoplastic material 24, 25 are placed with one on top of the other and have seals 26 at the outer portions 27 and a plurality of parallel flat bar seals 28 within the outer portions 27. The basic inflatable has an inflating valve 29 located on the top sheet 25 for injecting air into the space between said two sheets 24 and 25. The lateral centerline is CL 1.

Magrid's central film 20 mentioned is a single film that separate chambers 22 are attached to, each with a separate valve 23.

Each chamber would need to be inflated and deflated independent of all others, defeating the purpose of air being able to move to another chamber in a zone when impact occurs. Chambers under impact pressure may simply bust causing the package to move possibly impacting other chambers destroying the integrity of the packing system



My central film is actually a complete third film layer the same size as both outer layer films positioned in between the two outer film layers, creating four separate zones, two zones above the central layer and two zones below the central layer. Creating an even more impact resistant pad because now an impact on a zone is cushioned by the separate zone below, spreading the force of the impact over several other zones. It is still designed to be filled when constructed and can be reused in that state. Or can be deflated by cutting open the portal tube and reused at a later time by simply blowing on the portal tube that fills all zones and all chambers in one action.



Office statement "Magrid discloses the claimed invention except for a second layer on the opposite of the first layer which formed separate areas on the pad surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place individual sheets of plastic on the opposite side of the central layer which are sealed to the central layer to form inflatable areas having their own valve control on the surface of the article, since it has been held that mere duplication of the essential working parts of an article involves only routine skill in the art." Magrid's invention more closely resembles Jaszai or Soroka if designed as a impact resistant wrapping packing system. Just adding a second layer of film on the opposite of the first layer, would not provide a high profile void fill pad with four separate zones each containing connected coned shaped air chambers designed specifically to be high impact protection for void fill applications. Adding that second film with multiple valved chambers would make this a very costly void program and would more closely relate to Jaszai meant to wrap an article.

Ms. Nordmeyer I hope my confusion in the last Office Summary statements made some sense.

Finally in your conclusion

"The prior art made of record and not relied upon is considered pertinent to applicant's disclosed. U.S. Patent No. 4,465,188 to Soroka et al is cited to show the state of the art."

In this statement I understood your direction to hold my invention out as void fill, where Mr. Soroka writes in his abstract "there is provided a light weight, simple and inexpensive, inflatable packaging structure in which an inflatable inner liner attached within an outer envelope comprises two inflatable zones each incorporating a plurality of inflatable cells with the cells of one of the zones alternating with the cells of the other zone. Thus with the inner liner inflated and the fragile or delicate articles disposed between two superposed layers of the liner the article is still substantially protected by the inflated cells of the zones even if the other zone is punctured." This I understand to be an impact resistant wrapping system, since the article is placed inside and inflated envelop similar to that described in Jaszai's figures 16, 23 and 24 all of whose low profile is suitable for an article wrap but not suitable for the larger volumes required of void fill. My invention is not designed to wrap a pad around an article but to be placed around an article already wrapped with Jaszai and Soroka wrapping system or the current bubble wrap system mine is to prevent that wrapped article from moving around in its shipping box. Mr. Soroka's invention can not be inflated when constructed, because it requires the article to be placed inside before inflation, Mr. Soroka, Mr. Jaszai and Mr. Magid all have and require valves or taps structures that are separate from the main film body, requiring additional cost in producing such valve structures and additional cost in producing each pad because of the insertion and sealing of these valve structures. My invention is designed to be inflated when it is created and has no valve structures added as separate units to the main film. As void fill it can be used to support many different sized and shaped articles in a carton, wrapping systems, like Soroka, Jaszai and even if Magid is

used as a wrapping system will have a defined limit to the size and shape article they can accommodate.

Ms. Nordmeyer , thank you for your patience this was a long review , but I wanted to make sure I did not miss any of your directions.

I am also enclosing several sheets ( Four Marketing Cards) describing the invention with a more graphic approach that I am using to describe my invention. I hope it will help give a more complete picture of the invention's unique properties.

Thank you for your time and your efforts,  
Looking forward to hearing from you at your earliest convenience.  
Sincerely,

Thomas Louis Russo.

Enclosed:

1 – copy of a marked claims showing revised text in a brick color and text to be eliminated in parentheses in a blue color. There are 2 actual sheets

2- Clean copy of the revised claims. There are 2 actual sheets

3- This thirteen page review of the requests in the Office Action Mailed Nov 5 2002.

4- Four Marketing cards that use a graphic format for explaining pad features

5- Return Post card outlining all of the parts of this mailing , so that we may know that you received the complete package.

6- Certificate of Mailing under 37 CFR 1.8

Would it possible for you to call me at 802-775-5242 when you receive this mailing, I would like to know if I have done the right things to get my invention accepted for a US Patent.

Application Control Number 09/911,949  
Applicant: Russo, Thomas Louis  
Art Unit: 1772  
Examiner: Patricia L. Nordmeyer

June 17, 2003

Dear Ms. Nordmeyer,

The following pages reflect my understanding of the changes and corrections you requested in your Office Action of March 22 2003. Please accept the changes necessary to consider my application for patent valid and complete.

I thank you for your efforts and ask that you continue to help me get this application to an approved patent.

I have included a marked up copy of claims as well as a clean version of claims to be considered for my application.

Thank you,

Thomas L. Russo

In an effort to better identify and clarify my invention, I submit the following corrections to my claims, in the hope that the examiner will find this wording more acceptable.

I have tried to make it more evident that my invention is in fact valve less in its design for production use, and that there are no valves between chambers in a zone to control air flow.

I have also tried to make it more definitive that this invention is not designed to replace Mr. Jaszai or Mr. Magid inventions that wrap an article or enclose an article to be shipped, but to work with their inventions to provide an invention that will be the void fill between their inventions and the interior surface of the shipping box. I noted that in this regard the examiner stated that Mr. Jaszai and Mr. Magid inventions could be inflated as void fill, but they were not designed for this purpose, it is certainly not commercially acceptable because their designs require a single unit production to create their pocket effect. My design is developed specifically for void fill in that its production is not of a single unit but of dozens of units all attached with perforated boundaries that can be left together as sheets or separated and distributed throughout a shipping carton. Mr. Jaszai and Mr. Magid inventions are not only impractical in terms of economy, an over built pad for a simple use, but each of their inventions requires individual inflation, because they are designed to wrap around an object, they can not be pre inflated. My invention is produced inflated; it could be produced hundreds at a time, already inflated. The only way this invention will work as it was intended is to be extremely economical to compete with the Styrofoam beans that it is intended to replace or at least reduce, to help reduce the effects on ecology by providing an alternative deflatable reusable pad in place of the large volumes of Styrofoam bean discarded each year. I must say it is quite disturbing to see the examiner suggest that two inventions not intended for void fill could be used as such; it is almost as if anything could be void fill, bed pillows, rags, rolled up news paper, cabbage, gold, etc. It is extremely frustrating to know you have an invention designed to meet a specific need and to be faced with a response from an examiner that makes it impossible to understand their role in reviewing

solutions to current needs. How can an applicant hope to overcome this approach to logic? Another point of logic is the examiners use of "prior art" that based on prior art someone could have determined exactly what I am proposing.

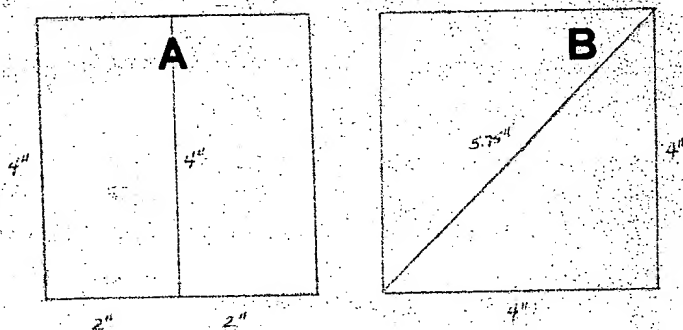
It has been 4 years since Mr. Jaszai Oct 1998 and 16 years Mr. Magid Dec. 1986 obtained their patents. First question is, why would they have ever considered a conical shape, their inventions work great for what they were intended for, they were not designing void fill, they were designing object protection. How does an applicant respond when an examiner says that someone in the art would have uncovered this approach to develop a higher volume pad using simple geometry. I am thinking that I am that someone, this invention has the interest of the industries leaders in air packing systems, many of them own that prior art you referred to, they feel that this invention may have solved a problem that has been plaguing this industry and inflatable void fill that is reusable and has backup zones incase one zone of a pad fails. NO one to date had conceived this approach to solve this need, and the examiner states based on prior art someone would have, again I believe I am that someone. Isn't that what invention is about? There are some 1500+ patents on washing machines, if we take the examiners direction to prior art, certainly the industry would have suffered based on the first washing machines prior art. As an applicant I try very hard to consider what the examiner is thinking when it is said that my invention without vales, conical multiples zones to provided extra security and higher pad profile, is like Mr. Jaszai and Mr. Magid. When certainly as the examiner researched present patents to review against my invention, the examiner must have recognized that almost all of the patents selected do the exact same thing as each other. Mr. Jaszai and Mr. Magid inventions do exactly the same thing in exactly the same way, and Mr. Magid was awarded his patent twelve years before Mr. Jaszai. As an applicant asked to review their patents against my invention, I am wondering how their patents were issued because certainly "prior art" would have made it impossible to be considered different. How would the PTO explain that logic direction? And if what the examiner is saying is true that a conical shape was actually the development of prior art then there should never



be a patent awarded for any conical shaped packing pad void fill invention, whether it is mine or another inventor.

The examiner states, That shape is not relevant in my invention over Mr. Jaszai and Mr. Magid, but it certainly is relevant without the conical shape my pad does not work, Mr. Jaszai and Mr. Magid do not require a conical shape for their inventions to work. If my invention does not work without the conical shape it must have some relevance.

The examiner continues to use the one case where a bottle top in the form of the upper portion of a human body was not awarded a patent simply because of shape. Shape in the bottle top was merely a development of design not function but how does that relate to a conical shape that is the functional element that creates higher volume pad because of its shape, when the bottle top is still just a bottle top with no additional function to its shape difference. The examiner can best answer this issue of shape being paramount to this invention, by asking one question; Can you get a high volume pad with zone identity without using the conical shape? Reference the example below, the answer is, NO you can not get a high volume pad without the conical shape; therefore the shape must be relevant to this invention.



From my November response to PTO Office Action

The sketch above will hopefully help illustrate the statement that a chamber height is determined by its smallest dimension. A and B represent a four inch square, consider then inflatable pads. When we divide pad A in half using a rectangle chamber like Mr. Jaszai's wrapping pad the smallest dimension is 2 inches, but when you use a cone shape or triangle shape similar to pad B like our pad the smallest dimension is 4 inches. The cone shape does make a significant difference in obtaining a higher pad profile providing a void fill pad with greater impact protection and requiring less void fill pads to pack like shipping boxes using lower profile pads.

Below are the marked up claims to help improve the clarity of the invention requested by the examiner.

### Claims

**What is claimed is:**

1. An impact- resistant valve less inflatable reusable two zoned void fill packing pad for protecting articles during shipping from shock and damage, said packing pad made of a first and second outer film layers, said first and second film layers being secured together along an outer perimeter thereof to define a entry/exit portal tube passageway to permit repeated packing pad use and the inner volume within said pad and, said first and said second film layers within said inner volume in a location selected to form two separate zones within said inner pad volume, and each said zone made up of inflatable chambers, wherein said chambers are conical shaped providing a high volume profile with added zoned impact security .
2. The system of claim 1, wherein each said zone is comprised of a plurality of inflatable valve less conical shaped chambers configured to redistribute an inflation gas contained therein from one or more conical shaped chambers compressed by and external impact to at least one contiguous conical shaped chamber which is not impacted.
3. The system of claim 2 , wherein said conical shaped chambers maximize pad height for impact protection, said pad height respective of available chamber height, determined by base width of conical chambers provided.

4. An impact- resistant valve less inflatable reusable four zoned void fill packing pad for protecting articles during shipping from shock and damage, said packing pad made of a first and second outer film layers with a complete central film layer, said first and second film layers being secured to the central film layer along an outer perimeter thereof to define a entry/exit portal tube passageway to permit repeated packing pad use and the inner volume within said pad and , said first and said second film layers within said inner volume in a location selected to form four separate zones within said inner pad volume, and each said zone made up of inflatable chambers, wherein said chambers are conical shaped providing a high volume profile with added zoned impact security .

**The following is a clean revision of the claims I would like the examiner to consider for my invention.**

## Claims

### **What is claimed is:**

1. An impact- resistant valve less inflatable reusable two zoned void fill packing pad for protecting articles during shipping from shock and damage, said packing pad made of a first and second outer film layers, said first and second film layers being secured together along an outer perimeter thereof to define a entry/exit portal tube passageway to permit repeated packing pad use and the inner volume within said pad and, said first and said second film layers within said inner volume in a location selected to form two separate zones within said inner pad volume, and each said zone made up of inflatable chambers, wherein said chambers are conical shaped providing a high volume profile with added zoned impact security .
2. The system of claim 1, wherein each said zone is comprised of a plurality of inflatable valve less conical shaped chambers configured to redistribute an inflation gas contained therein from one or more conical shaped chambers compressed by and external impact to at least one contiguous conical shaped chamber which is not impacted.
3. The system of claim 2 , wherein said conical shaped chambers maximize pad height for impact protection, said pad height respective of available chamber height, determined by base width of conical chambers provided.
4. An impact- resistant valve less inflatable reusable four zoned void fill packing pad for protecting articles during shipping from shock and damage, said packing pad made of a first and second outer film layers with a complete central film layer, said first and second

film layers being secured to the central film layer along an outer perimeter thereof to define a entry/exit portal tube passageway to permit repeated packing pad use and the inner volume within said pad and , said first and said second film layers within said inner volume in a location selected to form four separate zones within said inner pad volume, and each said zone made up of inflatable chambers, wherein said chambers are conical shaped providing a high volume profile with added zoned impact security .

Ms. Nordmeyer,

As a separate inquiry I do not understand the PTO's position in this Office Action. I waited 18 months before the PTO's first response to my application, I answered that in the required 3 months and the very next response is a FINAL ACTION. Is the PTO all about process and efficiency... 18months ??? or about patent solutions to industries needs. This is aside from my formal office response above, but it certainly is a question that comes to mind, when an applicant like myself is looking toward the PTO to help me acquire patent protection for an invention.

Thank you for your efforts on my behalf, is it possible that this response and my response in November be submitted to the Assistant Director of Patents, so that in forming new and better process for the PTO that they might consider an applicants point of view?

Once again thank you, and if you have any questions about my response please call me at 802-775-5242.

Thomas L. Russo

Application Control Number 09/911,949

Art Unit: 1772

Examiner: Patricia L. Nordmeyer



September 19, 2003

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Application Control Number 09/911,949  
Applicant: Russo, Thomas Louis  
Art Unit: 1772  
Examiner: Patricia L. Nordmeyer

Dear Ms. Nordmeyer,

This letter is my understanding of your Advisory Action post marked July 1, 2003. I will attempt to complete your Advisory Actions points, by pasting your direction followed by my understanding.

Thank you in advance your help with my application.

Sincerely,

Thomas L. Russo

Thomas Russo response to Advisory Action post marked July 1 2003 from Patricia Nordmeyer ,  
application # 09/911,949

Tom Russo Tel: 802-775-5242 email: [RussoArt@aol.com](mailto:RussoArt@aol.com)

Page 1 of 5

**DETAILED ACTION**

**Continuation of #2:** Applicant has amended independent claims 1 and 4 by adding proposed new limitations "valve less" which require a new search and or further consideration.

**ENTRY NOT**

It should be kept in mind that applicant can rejected claims, add new claims after a final previously canceled claims.

Except where an amendment merely cancels removes issues for appeal, or in some other examiner, compliance with the requirements expected in all amendments after final rejection 1.113 to the final rejection results in abandonment to:

- (A) an amendment complying with
- (B) a Notice of Appeal (and appeal)
- (C) a request for continued examination submission (i.e., an amendment that meets 1.111) and the fee set forth in 37 CFR 1.114 does not apply to utility or plant patent 1995 and design applications.

**Continuation of #5:** The application is not Applicant's arguments are drawn to a proper Thus, the arguments are not commensurate applicant's arguments are drawn to the limit Therefore, the arguments are moot as they

record. Applicant's arguments of record are not found persuasive because they rely on the non-

**Response:**

The use of the words valve less was to help clarify my claims as you suggested in your office action of March 22 2003. The words valve less was an attempt to categorize the type of inflatable system used. Valve less inflatable verses valved inflatable. For example current void fill pads used commercially today have no valves such as the inflatable air cushions mentioned in the "background of invention" section in my application as opposed to the valved air cushions also mentioned in the background of inventions. I was trying to clarify as you requested that this was one of the valve less types. The valve less category already exists in today's packing programs. Every thing from bulb wrap to air cushion pillows.

I would have hoped that after reviewing all of the parts of my application, summary of invention, brief description of drawings, detailed description of invention, and my abstract, that it would have been obvious that this is of the valve less inflatable type. There is no valve because the pad is inflated when it is produced; it only has an exit and entry portal tube that is cut open if you plan to reuse the air pad. That is why it did not appear in my original claims that you rejected, because it was not clear why my invention was different than Mr. Jaszai and Mr. Magid inventions.

Removing the words valve less from my claims will not alter the effectiveness of my invention. Anyone producing this pad would certainly realize there are no valves to be installed.



Art Unit: 1772

entered amendments. Applicant is referred back to the final rejection of record in Paper #5, mailed on March 19, 2003.

Applicant is asked to read the following section (b) from the *Manual of Patent Examination Procedures* regarding the 37 CFR 1.116 regulations when amending claims after final rejection. Applicant's amendment to the claims has not been entered and prosecution has been closed on the case after the final rejection filed on March 19, 2003. The amendment to the claims changes the claimed structure of the invention, which would require a new search for prior art which reads upon the structure claimed in the new claims.

**§ 1.116 Amendments after final action**

(a) An amendment after final action or a final rejection is not allowable under this section.

(b) After a final rejection or other final action, an amendment to the claims or parts reexamination filed under § 1.510, or

1.949) in an inter partes reexamination filed

made canceling claims or complying with the requirements set forth in a previous Office action. Amendment to the claims for consideration on appeal may be made only if the applicant admits, any amendment after a final rejection, prosecution, or any related proceedings with respect to the application from abandonment under § 1.116, or termination. No amendment can be made in a proceeding after the right of appeal notice is given in paragraph (d) of this section.

(c) If amendments touching the merits of the invention are presented after final rejection, or when such amendment might not otherwise be made upon a showing of good and sufficient reasons not earlier presented.

**Response:**

So basically what you are saying here is because you did not understand that from the beginning that this is and always was an infallible pad system without valves. And now that I stated what was obvious to anyone who understands the art of producing and developing inflatable packing systems to clarify your request, my application requires a new search.

It seems as though I am paying a penalty for you not understanding the invention. How do you explain that and where in your amendments, and appeals, and matter of right, etc., etc. is that reflected in your advisory or office action.

If you had understood it from the beginning you would have never suggested that it was the same as Mr. Jaszai and Mr. Magid. Now that you have done that you can not retreat, can you? Lets blame the applicant he is adding new information. Look you were wrong to suggest that my invention was the same as Mr. Jaszai and Mr. Magid, they were not even designed for the same purpose, but you tried to squeeze it into some configuration that suggest it was the same. Shame on you... admit these are not the same, and lets move on. Most applicant do not want to steal someone else's invention. If there is an invention that is the same as mine and it is prior to mine then that is great, commerce can use this type of product for all the reasons mentioned in the Background of invention section. I do not want to infringe on someone else's invention.... How can you help me with this issue?

Art Unit: 1772

(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 1.196 or § 1.977.

Regarding section (a) of 37 CFR 1.116, the amendments must comply with 37 CFR 1.114. As explained in section (b), the amendments must place the rejected claims in better form for consideration in order to be entered. The amendments presented in the reply fail to meet this criteria. Nor, do the amendments or the arguments show sufficient reasons as to why the amendments were necessary and not presented earlier in the prosecution, section (c). Section (d) is not applicable at this present time.

An examination of this application reveals prosecution procedure as the arguments presented towards limitations which are contained in the claims are not clearly stated in the specification. When an inventor of skill in this field usually acts as a liability in the invention disclosed. Applicant is advised to select an agent to prosecute the application, since the inventor's preparation and prosecution. The Office cannot

Applicant is advised of the availability of Registered to Practice Before the U.S. Patent and Trademark Office by the Superintendent of Documents, U.S. Government Printing Office 20402.

**Response:**

You are right I don't understand the proper phrasing, and legal confusion necessary to get an application approved. I am just an everyday person with an idea.

Your suggestion to retain a patent attorney, to help the PTO process my application is appreciated but not possible.

The average patent could cost between \$10,000 to \$20,000, just to get it to this point. Even if it was only \$5000, it still puts patenting ideas outside of the reach of most of our nation's citizens. For the sake of PTO process we are making patent protection available only for the rich and industry applicants. It seems unbelievable that I have to hire an attorney to intervene through the patent application process to work with a government agency that I already pay for either directly or indirectly. Does that seem right to you, when I wouldn't need an attorney at all, if the examiner's direction was to instruct me on how to get my application approved, rather than why it can't be approved.

I know this issue is above your job scope, but you did the right thing by suggesting I get an attorney, to protect any repercussions that may occur between the PTO and a home inventor applicant.

I need your help as my examiner, how do I need to arrange my words to meet your needs?

The specification of the applicant should clearly state and include all of the limitations and embodiments of the claimed invention in order for the patentability of the invention to be determined by the Examiner. It may be in the best interest of the Applicant to file a continuation or continuation-in-part of the invention where the structure of the article is clearly disclosed and claimed, both in the article's initial use and in its reusable state.

Any inquiry concerning this communication  
examiner should be directed to Patricia L. Nordmeyer  
5480. The examiner can normally be reached  
Fridays.

If attempts to reach the examiner by telephone  
supervisor, Harold Y. Pyon can be reached on  
organization where this application or proceeding  
communications and (703) 872-9311 for After

Any inquiry of a general nature or relating  
should be directed to the receptionist whose telephone

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
June 26, 2003

**Response:**

If you are speaking of the words valve less it is neither a limitation or a select embodiment. It is a commercial category of an inflatable item. My invention has no valves and is classified in that group. Anyone reading my application, even with a cursory knowledge of the art of inflatable packing materials would understand there is no valve. I stated valve less because you directly compared my invention to Mr. Jaszai and Mr. Magid, and the most obvious difference was that they are of the valved inflatable class and my was valve less, this was one of several differences, between my invention and theirs. The words valve less is not necessary because there is no mention of valves in the description of my invention, or any other sections of my application that presents my invention.

Inquiry about this application is very difficult because of my job requirements, I am not available from 6:30AM to 6 or 7 PM Monday through Friday. If we can pre arrange a lunch time call I will try and have the necessary information at work so we can communicate by phone.

I still believe this application, and all its office actions and advisory actions and my responses should be reviewed by your internal committees that are charged with improving the PTO's interface with Home Inventors. This might help you in your position, and other applicants like myself.

I am sorry if my frustration is apparent in this response.